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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,450	04/20/2001	Jo Melinna Giannini	12334.02	2289

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EXAMINER

GOTTSCALK, MARTIN A

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/838,450

Applicant(s)

GIANNINI, JO MELINNA

Examiner

Martin A. Gottschalk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04/20/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Notice to Applicant*

1. Claims 1 and 2 have been examined.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al (US Pat# 4,858,121) in view of Liff et al (US Pat# 2003/0074218).

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A. As per claim 1, Barber discloses a method of doing business by encoding, documenting and processing the procedures of alternative healthcare provider treatment, using a computer system having a programmable memory and a central processing unit comprising the steps of:

programming a computer system having a programmable memory and a central processing unit for operating a business;

inputting and encoding a patient pool in the computer system;

inputting and encoding a procedure claim from an alternative health provider for treating a patient in the patient pool;

(See Barber: col 3, lns 25-47 and Fig. 1 for the previous three steps. The Examiner considers the physicians recited by Barber to be forms of alternative health providers.)

inputting and encoding a data base of a plurality of alternative healthcare providers to yield an alternative practice type (APT) code to identify the provider (Barber: Fig. 1, reads on Physician File; col 1, ln 65 to col 2, ln 6; col 4, lns 13-15. The Examiner considers "physician identification cards" to be forms of alternative practice type codes);

choosing and retrieving an APT from the APT data base and matching with the provider's procedure claim (Barber: col 6, lns 29-49, Fig. 5B, items 154-160);

inputting and encoding a database of alternative billing codes (ABC) for each of the plurality of alternative healthcare provider categories to yield a

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standard alternative billing code (ABC) data base (Barber: col 12, Ins 55-69; Fig. 1, items 622-630).

choosing and retrieving an ABC from the ABC data base and comparing to the APT for a diagnostic match with the performed procedure (Barber: col 6, Ins 29-49);

providing a provider data (PD) data base by regional location based on zip codes (Barber Fig. 1. Provider database reads on Physician File. Note the Zip Code File. Further note that the provider database contains zip codes by patient - col 4, Ins 63-65 - and by insurer – col 6, Ins 2-3);

selecting a provider from the PD data base (Barber: col 4, Ins 39-43);

generating a specific ABC cost (Barber: col 6, In 31, reads on medical service fee) and comparing with a diagnosis code (Barber col 6, In 30, reads on basic claim information) to form a comparison table of costs for the procedure; and

sending the comparison table to an insurer or a third party administrator for payment to the alternative health care provider (Barber: col 6, Ins 29-49).

Barber fails to explicitly disclose the use of

Universal Product Code (UPC) and a National Drug Code (NDC) for detailed information.

However, these features are well known in the art as evidenced by the teachings of Liff.

Liff discloses the use of a NDC number (Liff: [0127]) in conjunction with a UPC code (Liff: [0055]; Fig. 1, item 98) to provide detailed information on a drug.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Barber with those of Liff for the purpose of combining a billing system efficiently with a medication management system appropriate for a medium size facility (Liff: [0008]) such as a multi-physician-practice, which is the scale for which the system disclosed by Barber is designed.

5. As per claim 2 it recites a programmed computer assembly which repeats the same limitations of claim 1 the corresponding method claim, as a collection of elements as opposed to a series of process steps. Since the teachings of the cited references disclose the underlying process steps that constitute the methods of claim 1, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claim 1 are rejected for the same reasons given above for claim 1.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not relied upon prior art discloses a system for managing prescription information including information about herbal medications and supplements (US Pat#, 6,421,650).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone

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number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MG  
07/21/2005



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SUPERVISORY PATENT EXAMINER